

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: *Gross* ) Art Unit: 3629  
Serial No.: 10/771,049 )  
Filed: 02/02/2004 ) Examiner: *Rubl, Dennis W.*  
For: *Notification system and method for media queue* )

**PETITION TO CONSIDER OCTOBER 10 IDS SUBMISSION**

Office of Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant respectfully petitions for the PTO to consider at least some of the references cited in the October 10 2007 IDS filed in the present application, and to issue a Supplemental Notice of Allowance. The petition is supported by the present facts and discussion, as well as the attached declaration of the undersigned:

1. The original IDS included some 22 references, including 15 patents/publications, and 7 NPL documents. A redacted version is attached hereto as Exhibit A.
2. In the Examiner's Office Action of November 27, 2007, he indicated that because some of the references (seven in fact) in the IDS had *already* been presented in the present prosecution, he would not consider *any* of the references in the IDS. The Examiner made this conclusion based on the fact that the certification under 1.97(e)(2) was in erroneous for the aforementioned seven references.
3. Applicant submits that the Examiner should nonetheless at least consider the other references for which the certification was accurate as explained below. The mistaken claim on the certification for the other 7 references was merely the result of a clerical error which occurred during the IDS electronic submission process. In any event, Applicants should not be penalized for being (mistakenly) over-inclusive while making earnest efforts to comply with the PTO procedures.

Brief Summary and Discussion

4. The present application is related to a series of other applications previously identified to the Examiner, including at least the following:
  - a. 10/770,664 filed on 02-02-2004 - Media auto exchange system and method; Group Art Unit 3629; Examiner: Ruhl
  - b. 10/770,742 filed on 02-02-2004 - Media exchange system & method – Group Art Unit 3629; Examiner: Ruhl
  - c. 10/770,767 filed on 02-02-2004 - Media queue monitor – Group Art Unit 3625; Examiner: Smith
  - d. 10/770,804 filed on 02-02-2004 - System for providing access to playable media - Group Art Unit 3622; Examiner: Affaf
  - e. 10/770,937 filed on 02-02-2004 - Method of providing access to playable media - Group Art Unit 3625; Examiner: Rosen
  - f. 10/771,094 filed on 02-02-2004 - Media queue replenisher - Group Art Unit 3621; Examiner: Ruhl

See Gross Declaration, paragraph 2.

5. On or about October 10, 2007 the undersigned's paralegal compiled a list of materials which were cited in these related cases and which were not already of record in the present application. The materials identified by the paralegal were presented in an IDS submitted to the PTO on October 10, 2007 ("IDS"). See Gross Declaration, paragraph 3.
6. The Examiner's Notice of Allowability mailed November 27, 2007 – Attachment A – indicates that *no* references in the IDS were considered, because *some* of the references identified therein were noted by the Examiner to have already been considered in the current prosecution some months ago, and thus were known to the Applicant prior to the 3 month certification period specified in 1.97(e)(2). The Examiner's observations are correct, and the Applicant has recognized the error in the IDS. As explained below, the erroneous inclusion of these references is simply the result of honest clerical cut and paste mistakes in compiling the IDS list which led to over-inclusion of materials that were not necessary in light of the fact that they had already been disclosed. In the one other instance there is a simple misunderstanding on what import the item on the list is supposed to have. See Gross Declaration, paragraph 4.

7. Applicant has re-reviewed the list and submits that the PTO should at least consider the items which the Examiner acknowledges do not raise any certification issues. The items which were already considered have been redacted (struck out) in the IDS and re-presented herewith. See Gross Declaration, paragraph 5.

Inadvertent inclusion of certain references:

8. The Examiner notes that NPL items #4 and #5 on page 3 of the IDS were previously considered in the present prosecution some months ago. Thus, they were known to Applicant more than 3 months ago, and hence should not have been the subject of a 1.97(e)(2) certification. The Examiner also suggested that several other patents and publications were mistakenly included. See Gross Declaration, paragraph 6.
9. Applicant has reviewed the list of 15 references again carefully, and notes that only the following five (5) were inadvertently included:

Page 1:

- g. #3: 6,317,722
- h. #7: 6,874,023

Page 2:

- i. #6 Publication No. 20030078983
- j. #7 Publication No. 20040242208
- k. #8 Publication No. 20020058496

See Gross Declaration, paragraph 7.

10. The two NPL references noted in paragraph 6 and the other 5 references noted above in paragraph 7 were not intended to be included in the IDS as they have already been considered during the present prosecution. These items were inadvertently included on the IDS because the Applicant's paralegal, while compiling the IDS for companion case 10/771,094 (which the present Examiner is also handling), mistakenly left such items on the list for the IDS for the present case, namely 0/771,049. In other words, the references intended for 10/771,094 were copied over for to the present application during the electronic submission process to the PTO. The serial numbers are very close and this also contributed to the confusion and error. This clerical error was not noticed until the Examiner pointed it out. See Gross Declaration, paragraph 8.

11. In any event, Applicant apologizes for any inconvenience or confusion this may have caused. The newly submitted IDS should be in appropriate form for the Examiner to consider at this point, and Applicant respectfully requests consideration of the same. As the Examiner can see, the error was one of over-inclusion, and there was certainly no intent to not disclose any particular reference. See Gross Declaration, paragraph 9.

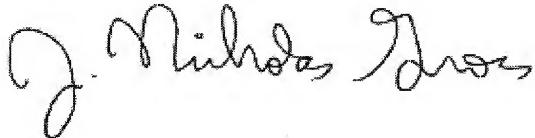
Examiner inquiry concerning submissions from related 10/770,937 application

12. The Applicant also submitted two items from related application serial no. 10/770, 937 including a Final Office Action mailed July 11, 2007; and 2) an Amendment and Response A filed via EFS April 11, 2007. These are items #6 and #7 on page 3. See Gross Declaration, paragraph 10.
13. Again, Applicant regrets and apologizes for any misunderstanding concerning the intended use of the Amendment and Response (item #7). The Applicant earnestly believed that the Examiner would be hampered and perhaps unable to determine the relevance of the July 11, 2007 Final Office Action (item #6) without the benefit of at least having an understanding of the language of the pending claims in such other case. Rather than submit yet another piece of paper that would confuse the process, or place the burden on the Examiner to locate such document in the related application, the Applicant merely elected to provide a copy of the Amendment and Response as a reference for the Examiner's benefit and ease of review of the Final Office Action. See Gross Declaration, paragraph 11.
14. The Examiner acknowledges that the certification was entirely proper as to the Final Office Action. Accordingly Applicant believes that it should have been considered as part of the IDS. See Gross Declaration, paragraph 12.
15. Conversely, until such time as the Examiner in the related '937 application issued the Final Office Action, there was nothing in the earlier amendment which could be remotely deemed relevant to the present application. Consequently Applicant submits that it is not necessary and the Examiner need not review the Amendment and Response as part of the newly submitted IDS, but it would seem somewhat difficult to comprehend and review the July 11 Final Office Action without consideration of the former. See Gross Declaration, paragraph 13.

16. For this reason the Amendment and Response is presented again as an attachment to the Gross declaration, with the proviso that such is being provided for reference purposes only. It is attached hereto to prevent any further mistaken classifications or impressions for such document. See Gross Declaration, paragraph 14.

Based on the above, the Applicant requests that the October 10 2007 IDS, as redacted/amended and attached hereto, should be considered and made of record in the present proceedings. Because there is nothing nonetheless in such materials which are believed to impact the patentability of the present claims, the undersigned further requests the issuance of a Supplemental Notice of Allowability/Allowance.

Respectfully submitted,



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Registration No. 34,175  
Attorney for Applicant(s)

December 3, 2007  
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Fax (510) 540-6315

# EXHIBIT A - MODIFIED IDS

PTO/SB/08a (05-07)

Approved for use through 09/30/2007. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>( Not for submission under 37 CFR 1.99)</i>	Application Number		10771049
	Filing Date		2004-02-02
	First Named Inventor		Gross
	Art Unit		3629
	Examiner Name		Dennis Ruhl
	Attorney Docket Number		JNG 2004-5

U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code <sup>1</sup>	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1	6105006		2000-08-15	Davis et al.	
	2	6105021		2000-08-15	Berstis	
	■	■■■■■		■■■■■	■■■■■	
	4	6370513		2002-04-09	Kolawa et al.	
	5	6735778		2004-05-11	Khoo et al.	
	6	6055505		2000-04-25	Elston	
	■	■■■■■		■■■■■	■■■■■	

If you wish to add additional U.S. Patent citation information please click the Add button.

U.S.PATENT APPLICATION PUBLICATIONS						
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Examiner Initial*	Cite No	Publication Number	Kind Code <sup>1</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1	20010014145		2001-08-16	Kamel et al.	
	2	20020046129		2002-04-18	Nakagawa	
	3	20030023743		2003-01-30	Raphel et al.	
	4	20060031551		2006-02-09	Agresta et al.	
	5	20060218054		2006-09-28	Postelnik et al.	
		[REDACTED]		[REDACTED]	[REDACTED]	
		[REDACTED]		[REDACTED]	[REDACTED]	
		[REDACTED]		[REDACTED]	[REDACTED]	

If you wish to add additional U.S. Published Application citation information please click the Add button.

#### FOREIGN PATENT DOCUMENTS

Examiner Initial*	Cite No	Foreign Document Number <sup>3</sup>	Country Code <sup>2</sup> i	Kind Code <sup>4</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T <sup>5</sup>

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>( Not for submission under 37 CFR 1.99)</i>		Application Number	10771049
		Filing Date	2004-02-02
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		Art Unit	3629
		Examiner Name	Dennis Ruhl
		Attorney Docket Number	JNG 2004-5

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If you wish to add additional Foreign Patent Document citation information please click the Add button

#### NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>5</sup>
	1	LING, S., et al., "Using Two Object-Oriented Modelling Techniques: Specifying the Just-in-Time Kanban System," International Journal of Operations and Production Management, Vol.15, No. 9, pp.185-199, 1995.	<input type="checkbox"/>
	2	ANON., "Netflix IPO Tops Expectations, Stock's Debut Dazzles," Newsbytes News Network, May 24, 2002.	<input type="checkbox"/>
	3	ANON., "Apple Announces iTunes 3; Now with Revolutionary Smart Playlists, Audible.com & Sound Check," M2 Presswire, July 18, 2002.	<input type="checkbox"/>
		[REDACTED]	<input type="checkbox"/>
		[REDACTED]	<input type="checkbox"/>
	6	Final Office Action for 10/770,937, mailed July 11, 2007, 26 pages.	<input type="checkbox"/>
		[REDACTED]	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>( Not for submission under 37 CFR 1.99)</i>	Application Number	10771049
	Filing Date	2004-02-02
	First Named Inventor	Gross
	Art Unit	3629
	Examiner Name	Dennis Ruhl
	Attorney Docket Number	JNG 2004-5

**EXAMINER SIGNATURE**

Examiner Signature	Date Considered
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

<sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>( Not for submission under 37 CFR 1.99)</i>	Application Number	10771049
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	Art Unit	3629
	Examiner Name	Dennis Ruhl
	Attorney Docket Number	JNG 2004-5

### CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

- That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

**OR**

- That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

- See attached certification statement.  
 Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.  
 None

### SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/John N. Gross/	Date (YYYY-MM-DD)	2007-10-10
Name/Print	John N. Gross	Registration Number	34175

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: *Gross* ) Art Unit: 3629  
Serial No.: 10/771,049 )  
Filed: 02/02/2004 ) Examiner: *Ruhl, Dennis W.*  
For: *Notification system and method for media queue* )

**DECLARATION CONCERNING IDS SUBMISSION**

The undersigned, J. Nicholas Gross declares and states that,

1. I am the sole inventor of the subject matter of the above-captioned U.S. Patent Application. I am also the attorney of record who prepared and filed the above application.
2. The above application is related to a series of other applications previously identified to the Examiner, including at least the following:
  - a. 10/770,664 filed on 02-02-2004 - Media auto exchange system and method; Group Art Unit 3629; Examiner: Ruhl
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3. On or about October 10, 2007 my paralegal at my behest compiled a list of any materials which were cited in these related cases and which were not already of record in the present application. The materials identified by my paralegal were presented in an IDS submitted to the PTO on October 10, 2007 ("IDS").
4. The Examiner's Notice of Allowability mailed November 27, 2007 – Attachment A – indicates that *no* references in the IDS were considered, because *some* of the references identified therein were noted by the Examiner to have already been considered in the *Declaration for IDS*

current prosecution some months ago, and thus were known to the Applicant prior to the 3 month certification period specified in 1.97. The Examiner's observations are correct, and the Applicant has recognized the error in the IDS. As explained below, the erroneous inclusion of these references is simply the result of honest clerical cut and paste mistakes in compiling the IDS list which led to over-inclusion of materials that were not necessary in light of the fact that they had already been disclosed. In the one other instance there is a simple misunderstanding on what import the item on the list is supposed to have.

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Inadvertent inclusion of certain references:

6. The Examiner notes that NPL items #4 and #5 on page 3 of the IDS were previously considered in the present prosecution some months ago. Thus, they were known to Applicant more than 3 months ago, and hence should not have been the subject of a 1.97(e)(2) certification. The Examiner also suggested that several other patents and publications were mistakenly included.
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intended for 10/771,094 were copied over for to the present application during the electronic submission process to the PTO. The serial numbers are very close and this also contributed to the confusion and error. This clerical error was not noticed until the Examiner pointed it out.

9. In any event, Applicant apologizes for any inconvenience or confusion this may have caused. The newly submitted IDS should be in appropriate form for the Examiner to consider at this point, and Applicant respectfully requests consideration of the same. As the Examiner can see, the error was one of over-inclusion, and there was certainly no intent to not disclose any particular reference.

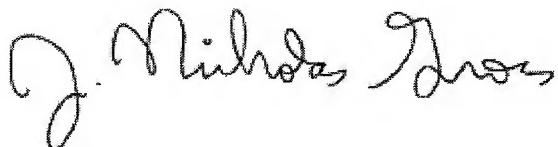
Examiner inquiry concerning submissions from related 10/770,937 application

10. The Applicant also submitted two items from related application serial no. 10/770,937 including a Final Office Action mailed July 11, 2007; and 2) an Amendment and Response A filed via EFS April 11, 2007. These are items #6 and #7 on page 3.
11. Again, Applicant regrets and apologizes for any misunderstanding concerning the intended use of the Amendment and Response. The Applicant earnestly believed that the Examiner would be hampered and perhaps unable to determine the relevance of the July 11, 2007 Final Office Action without the benefit of at least having an understanding of the language of the pending claims in such other case. Rather than submit yet another piece of paper that would confuse the process, or place the burden on the Examiner to locate such document in the related application, the Applicant merely elected to provide a copy of the Amendment and Response as a reference for the Examiner's benefit and ease of review of the Final Office Action.
12. The Examiner acknowledges that the certification was entirely proper as to the Final Office Action. Accordingly Applicant believes that it should have been considered as part of the IDS.
13. Conversely, until such time as the Examiner in the related '937 application issued the Final Office Action, there was nothing in the earlier amendment which could be remotely deemed relevant to the present application. Consequently Applicant submits that it is not necessary and the Examiner need not review the Amendment and Response as part of the newly submitted IDS, but it would seem somewhat difficult to comprehend and review the July 11 Final Office Action without consideration of the former.

14. For this reason the Amendment and Response is presented again as an attachment hereto, with the proviso that such is being provided for reference purposes only. It is attached hereto to prevent any further mistaken classifications or impressions for such document.
15. All statements made of my own knowledge are true and all statements made on information and belief are believed to be true; I further acknowledge that wilfull false statements are punishable by fine or imprisonment, or both, under Section 1001 of Title 18, and that such may jeopardize the validity or enforceability of the application and/or any patent issued therefrom.

Executed in Berkeley, California, on December 3, 2007

Respectfully submitted,



J. Nicholas Gross  
Registration No. 34,175  
Attorney for Applicant(s)

December 3, 2007  
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Tel. (510) 540-6300  
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# **ATTACHMENT TO GROSS DECLARATION**

Attorney Docket No.: JNG 2004-1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Gross	) Art Unit: 3625
	)
Serial No.: 10/770,937	) Examiner: Rosen, Nicholas
	) D
Filed: 02/02/2004	)
	)
For: <i>Method of providing access to playable</i>	)
<i>media</i>	)

## AMENDMENT & RESPONSE - A

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant submits the following in response to the Office Action mailed October 11 2006. Amendments to the claims begin on page 2. Remarks begin on page 8.

### IN THE CLAIMS:

Please enter the following as a complete listing of the pending claims:

1. (Currently Amended) A method of distributing playable media items over an electronic network from a first computer maintained by a provider of a media distribution service to a second computer used by a subscriber of such service, the playable media items corresponding to machine readable media readable by a subscriber machine player, the method comprising the steps of:

  - (a) setting up a subscriber delivery queue for the subscriber to be controlled by the first computer, said subscriber delivery queue consisting of an ordered list of one or more playable media items to be delivered to the subscriber in a subscriber-defined priority;  
wherein said subscriber delivery queue is set up at least in part in response to item selection directions provided by the subscriber over the network using the second computer;
  - (b) setting up queue replenishment control rules for the subscriber delivery queue; and
  - (c) monitoring said subscriber delivery queue in accordance with said queue replenishment control rules to automatically determine with said first computer if an additional playable media item should be added to said subscriber delivery queue; and
  - (d) automatically modifying said subscriber delivery queue with said first computer to generate a new ordered list of one or more playable media items in response to the subscriber confirming that said additional playable media item can be included in said subscriber delivery queue;  
wherein said subscriber delivery queue is maintained automatically for the subscriber so as to include at least one playable media item which could be delivered to such subscriber.
2. (Original) The method of claim 1, wherein the subscriber does not need to be connected to the provider over the network during step (c).
3. (Original) The method of claim 1 wherein said ordered list of one or more playable media items are set up by said subscriber-defined priority in a delivery sequence ranging from a first playable media item to be delivered from said

- subscriber delivery queue to a last playable media item to be delivered from said subscriber delivery queue.
4. (Currently amended) The method of claim 3, wherein said additional playable media item is automatically inserted in a subscriber-defined delivery order position in said new ordered list of one or more playable media items.
  5. (Original) The method of claim 3, wherein said additional playable media item is automatically inserted as said first playable media item to be delivered from said new ordered list of one or more playable media items.
  6. (Original) The method of claim 3, wherein said additional playable media item is automatically inserted as said last playable media item to be delivered from said new ordered list of one or more playable media items.
  7. (Original) The method of claim 1, further including a step of: delivering playable media items to the subscriber based on said new ordered list of one or more playable media items.
  8. (Original) The method of claim 1, wherein step (d) is performed automatically without sending a further notification to the subscriber.
  9. (Original) The method of claim 1, further including a step (c)': sending a notification to the subscriber after step (c) when said queue replenishment control rules determine that said subscriber delivery queue should be modified.
  10. (Original) The method of claim 9, wherein said notification does not automatically trigger a modification of said subscriber delivery queue.
  11. (Original) The method of claim 9, wherein said notification specifies that said subscriber delivery queue will be automatically modified in accordance with said queue replenishment control rules.
  12. (Currently amended) The method of claim 9, wherein said notification specifies that said subscriber delivery queue will be automatically modified in accordance with said queue replenishment control rules and includes an embedded embedded uniform resource links (URL) or an electronic response field in said electronic notification so as to allow the subscriber to review playable media title recommendations from said recommender system.

13. (Original) The method of claim 12, wherein said subscriber delivery queue is automatically modified in accordance with said queue replenishment control rules after a predefined time delay.
14. (Original) The method of claim 9, wherein said notification provides directions for the subscriber to accept and/or modify said additional playable media item.
15. (Original) The method of claim 1, wherein said queue replenishment control rules include a trigger event to be used in determining when said subscriber delivery queue should be modified.
16. (Original) The method of claim 15, wherein said trigger event is associated with a quantity of playable media items remaining in said subscriber delivery queue.
17. (Original) The method of claim 15, wherein said trigger event is associated with a determination by an item recommendation system that said additional playable media item should be added to said subscriber delivery queue as a recommended playable media item.
18. (Original) The method of claim 17, wherein said recommended playable media item is designated as the next to be delivered from said subscriber delivery queue.
19. (Original) The method of claim 1, wherein said additional playable media item is automatically determined by a recommender system controlled by the provider of the media distribution service, which recommender system automatically identifies playable media items of interest to the subscriber based on a subscriber item preference profile.
20. (Original) The method of claim 19, further including a step of: processing an item rating survey provided by the subscriber to determine a subscriber item preference profile suitable for use by said recommender system.
21. (Original) The method of claim 1, wherein said additional playable media item is randomly selected from a list of playable media items associated with a category selected by the subscriber.
22. (Currently amended) The method of claim 1, wherein said queue replenishment control rules ~~for and~~ the subscriber delivery queue are set up automatically for the subscriber based on an evaluation of item preferences determined for the subscriber.

23. (Original) The method of claim 1, wherein said queue replenishment control rules for the subscriber delivery queue are set up by the subscriber.
24. (Original) The method of claim 1, further including a step (e): moving an item from said subscriber delivery queue to a shipping queue when the subscriber is eligible to receive an additional item.
25. (Original) The method of claim 19, further including a step of: processing an item rating survey provided by the subscriber to determine a subscriber preference profile suitable for use by said recommender system.
26. (Currently amended) The method of claim 1, further including a step of: receiving subscriber feedback concerning a performance of said media distribution service ~~concerning~~ concerning selection of said additional playable media item.
27. (Original) The method of claim 1, wherein a subscriber account is charged a fee when an additional playable media item is moved to said subscriber delivery queue.
28. (Original) The method of claim 1, wherein the media distribution service distributes movies to the subscribers.
29. (Original) The method of claim 28, wherein the media distribution service is an Internet based movie rental service, and the playable media items are recordings of movies that are mailed to subscribers.
30. (Original) The method of claim 29, wherein the subscriber pays a flat rate service fee for having a predetermined number of recordings checked out of the Internet based movie rental service.
31. (Original) The method of claim 30, wherein a subscriber account is charged an additional fee when an additional playable media item is actually distributed to the subscriber.
32. (Original) The method of claim 28, wherein said movies are distributed electronically to the subscribers.
33. (Original) The method of claim 32, wherein said movies are distributed by a satellite transmission to a satellite signal receiver.
34. (Original) The method of claim 32, wherein said movies are distributed by a broadband Internet-based connection.

35. (Currently amended) A method of distributing playable media items comprising the steps of:
- (a) setting up a subscriber selection queue for the subscriber, said subscriber selection queue consisting of a list of one or more playable media items to be viewed by the subscriber;  
wherein said subscriber selection queue is set up at least in part in response to item selection directions provided by the subscriber;
  - (b) setting up queue replenishment control rules for the subscriber selection queue; and
  - (c) automatically monitoring said subscriber selection queue in accordance with said queue replenishment control rules to automatically determine with a first computing system if changes should be made to said subscriber selection queue;  
wherein said monitoring includes analyzing the content and/or characteristics of other playable media items within said subscriber selection queue to determine said changes; and
  - (d) automatically modifying said subscriber selection queue with said first computing system to generate a new list of one or more playable media items based on a confirmation from the subscriber;  
wherein said subscriber selection queue is maintained automatically for the subscriber to include at least one playable media item which could be delivered to such subscriber.

36. (Currently Amended) A method of distributing playable media items over an electronic network to a subscriber of a media rental service, the method comprising the steps of:

- (a) receiving subscriber preference data for the subscriber during a first data session, including notification and shipment options;
- (b) generating a subscriber profile for the subscriber suitable for use by a recommender system;
- (c) processing said subscriber profile using said recommender system to identify a media item that is likely to be of interest to the subscriber ;
- (d) notifying the subscriber and shipping said media item to the subscriber in accordance with said subscriber preference data; wherein said media item can be automatically shipped to the subscriber after said first data session, and without requiring a second data session by the subscriber with said media rental service;
- (e) repeating step (c) to automatically select and maintain at least one additional media item to be available for immediate delivery to the subscriber at all times;
- (f) enabling the subscriber to accept delivery of said at least one additional media item and/or select another media item.

## REMARKS

Original claims 1 – 36 are pending. No new matter has been introduced by this amendment into the specification and/or claims.

Applicant appreciates the prompt and thorough review given by the Examiner. In response, Applicant has given the Office Action very careful consideration, and the above amendments and remarks below are intended to fully address each concern raised by the Examiner. Accordingly Applicant submits that the present case should be in condition for allowance.

The rejections are addressed through a combination of traverse, amendment and argument as noted below. Briefly:

- the double patenting rejections are addressed through a terminal disclaimer filed herewith; this should render the issue moot at this time;
- Claim 26: the word “concerning” has been corrected;
- The single prior art § 103 rejection based on Hastings et al (6584450) taken with Ostrom (and other official notices) is also addressed through specific amendments and arguments which clearly define patentable subject matter over any such teachings provided by such combination.

Reconsideration and favorable action is thus requested.

### Rejection under §103 – Claims 1 - 34

The Examiner has cited the combination of Hastings (6,584,450) taken in combination with Ostrom (Mercury News article, July 7, 2002) as making the present claims obvious. In some instances the Examiner has also relied on Official Notice as well as discussed below.

While Applicant believes there are several significant differences between the claims and the cited references, and there is a significant lack of suggestion/motivation to combine, the present discussion focuses primarily on the fact that it can be seen quite plainly that the Ostrom reference does not in fact teach “...modifying the subscriber queue based on a confirmation from the subscriber....” Accordingly a rejection under § 103 is improper; to make this distinction more clear nonetheless Applicants have amended the claim to further define over the reference.

Ostrom merely explains the state of affairs in this technology in June 2002; namely, that subscribers had to constantly monitor and adjust their queues – on their own – to make sure that they received new titles. Thus Ostrom says nothing about automatically determining whether an “additional playable media item” should be added to the queue. It is merely repeating the fact that subscribers could add such items manually. Similarly Ostrom does not “automatically” modify the subscriber queue, this is something that user must do on their own again. Finally, claim 1 has also been amended to read that the subscriber delivery queue is “...maintained automatically for the subscriber to always include at least one playable media item which could be delivered to such subscriber. This behavior provides the operational advantage again that the subscriber need not worry about checking or maintaining the queue to ensure an uninterrupted flow of movies. In some cases, as the Examiner can see from reviewing Hastings and the other prior art, movies for the subscriber can be skipped (because they are unavailable, or allocated to other users) leaving the subscriber with potentially no titles for delivery. This is undesirable since it can lead to customer dissatisfaction.

Consequently it is submitted that claim 1 clearly differentiates over the prior art of record and should be in allowable condition.

#### Dependent claims 2 – 34

The dependent claims should be allowable for at least the same reasons as above. Moreover, these claims should be allowable for the additional reasons set forth below.

Claims 4 - 6: the Examiner will note that Ostrom is not referring to an “additional playable media item”; it is referring to re-arranging a preexisting item in the subscriber’s queue, or letting the subscriber add something manually. Thus, it does not teach permitting the subscriber to define the automatic insertion point of a new item.

As concerns the “official notice” taken by the Examiner for the claims; in many instances the Applicant does not agree with the conclusion, but has not challenged the same. For example, Applicant does not argue the separate patentability of claims 20, 21, 25, 26, 27, 32, 33 and 34, but believes they should be allowable nonetheless for the reasons set forth above for claim 1.

For claims 5, 6 (page 9): Applicant does traverse the rejection for the following reasons. First, Applicant submits that the Examiner has not applied the requirements attendant to this principle in an adequate fashion. According to MPEP 2144.03 “...official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, ***or to be common knowledge in the art*** are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

In the case of claims 5 and 6 the “Official Notice” is clearly too broad, as the Examiner cites that it is “...well known to add items to the top or bottom of a list, according to circumstances...” However, the Examiner fails to consider that the case law above requires that this basic statement must be tied to the specific field of **art** in question, and not to some general common knowledge. In this instance the Examiner will note that the references in this field of art of playable media item distribution in fact say nothing at all about giving a subscriber a preference at all concerning the location of a new item, let alone whether it should be at the top or bottom of their queue. Accordingly Applicant does not agree that this fact has been unquestionably demonstrated as to defy dispute.

For claim 8: the Applicant agrees that neither Hastings nor Ostrom teach notifying a subscriber of an item selection. Nevertheless since they do not perform step (d) of claim 1 either, this is a moot point.

For claims 9, 11, 12, 14: again, as concerns the official notice taken by the Examiner for claims 9, 11, 12, 14 (pages 10 - 11): Applicant traverses the same for the following reasons. As above, Applicant submits that the statement by the Examiner is not properly connected to this field of art. Moreover the Examiner can in fact determine that the conventional playable media rental services in fact did not provide such

notification at the time of the filing of the application, despite the fact that at least one of them (Netflix) had been in operation for several years. Consequently the Applicant does not agree that this is an unquestionable fact in this area of technology. More specifically for claims 12, 14 as the Examiner agrees (see claim 8) the prior art does not sent out a notification of any kind, and thus teaches away from the invention of these claims.

Similarly for claim 13: the official notice is traversed, because the Examiner has not connected this particular alleged undisputed fact to this field of technology. Moreover as the Examiner can verify, the prior art in fact works quite different to this claim, suggesting in fact that it is entirely non-obvious. In the prior art the movies are sent out, and as they are returned, another one is sent out as soon as possible or practical given logistical constraints. In contrast, claim 13 specifically indicates that a predefined time delay is always interposed, which period could be the next business day for example to allow for more predictable behavior/deliveries and management of customer expectations.

For claim 16: see above; the Applicant traverses this taking of Official notice for substantially the same reasons. The Examiner can again verify that commercial services for media rentals at the time of the filing of the invention did not offer such functionality. In fact, for reasons which are readily apparent, such services may have believed it was more economically advantageous to not inform subscribers of deficiencies in their queues, again, teaching away from the invention of claim 16.

Claims 17, 19: while Hastings discloses a recommender system, it does not describe that such system automatically adds titles to the subscriber's queue. Furthermore, Hastings says nothing about bumping a recommended title to the top of the queue, as set out in claim 18.

Claim 22: this claim has been further amended to distinguish over the prior art, none of which teaches or suggests setting up the queue in this fashion.

Claim 35: this claim has been amended similarly to claim 1 and should be allowable for the same reasons. Moreover this claim states that the monitoring is done automatically and includes "... analyzing the content and/or characteristics of other playable media items within said subscriber selection queue..." to determine what changes should be made, if any to the same. This limitation is also not taught or suggested in the prior art, and is yet another reason why this claim should be allowed.

Claim 36 has been amended as well and should be allowable for substantially the same reasons articulated above.

#### Conclusion

The Applicant has fully addressed all the outstanding rejections, and submits that the above should place the present case in condition for allowance.

A petition and fee for a three month extension of time is also enclosed. Please charge any additional fees to deposit account no. 501-244. Should the Examiner wish to discuss anything related to this case in person, feel free to contact the undersigned at any convenient time.

Respectfully submitted,



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